

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP R. THRIFF
and CHARLES T. HEMPHILL

Appeal No. 1998-1109
Application No. 08/419,229

ON BRIEF

Before JERRY SMITH, RUGGIERO, and HECKER, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider our decision of February 28, 2001 wherein we sustained the Examiner's rejection of claims 1-19 under 35 U.S.C. § 103.

In our previous decision, we determined that the Examiner, based on the combination of the Stefanopoulos and Schmandt references, had established a prima facie case of obviousness which had not been persuasively rebutted by convincing arguments

Appeal No. 1998-1109
Application No. 08/419,229

of Appellants. In particular, we found that the Examiner's line of reasoning established proper motivation to the skilled artisan to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos.

Appellants have set forth several arguments alleging error in our original decision which sustained the Examiner's obviousness rejection. However, on reconsideration of our decision of February 28, 2001 in light of Appellants' comments in the Request for Rehearing, we find no error therein. We, therefore, decline to make any changes in our prior decision for the reasons which follow.

Appellants now argue that the Examiner has failed to meet the three-pronged criteria (Request, page 2) for establishing a prima facie case of obviousness set forth in In re Vaeck, 947 F.2d 488, 492, 20 USPQ2d, 1438, 1442 (Fed. Cir. 1991). In the Brief on Appeal, however, Appellants specifically argued only the failure of the Examiner to establish proper motivation for the proposed combination of references, the first step in the asserted three-step process for establishing a prima facie case of obviousness. The second step, i.e., a reasonable expectation of success, was not argued by Appellants, and the third step requirement that the combined references must teach all the claim

Appeal No. 1998-1109
Application No. 08/419,229

limitations was argued only in general terms. It is a requirement of 37 CFR § 1.92 that Appellants submit arguments in the Brief(s) specifying all of the errors made by the Examiner in the rejection.

In any event, we found in our original decision that the Examiner set forth factual findings concerning the differences between the claimed invention and the applied prior art (Answer, pages 4-8), and clearly stated why it would have been obvious to the skilled artisan to combine the prior art references to arrive at the claimed invention. Rather than present any objective evidence of nonobviousness, Appellants chose instead to rely strictly on attorney argument in the Brief. We weighed the factual determinations made by the Examiner, and the arguments made by Appellants, and decided that the Examiner had reached the correct result.

Appellants' arguments in the Brief which attacked the Examiner's finding of motivation for the proposed combination of references primarily focused on the alleged lack of teaching of a network environment. Appellants now argue (Request, pages 3 and 4) that the Examiner's assertion of proper motivation for combining the prior art references must fail since neither of the

applied Stefanopoulos and Schmandt references suggests "accessing the Web" or that Schmandt's speech interface is "user friendly."

We note that neither of these arguments was made by Appellants in the Brief. An argument not timely made is an argument waived. We nevertheless have reviewed our original decision and find no error in our finding of the obviousness to the skilled artisan of adding the speech interface techniques of Schmandt to the system of Stefanopoulos, nor in our reasoning which led to this conclusion. Our review of Schmandt did not overlook portions therein, as suggested by Appellants in the Request, which indicated that not all users found the speech interface to be useful or efficient. We did not, and do not find, that the lack of positive experiences by some users of the speech interface of Schmandt would teach away from the Examiner's proposed combination, as implied by Appellants' arguments in the Request, when the entirety of Schmandt's disclosure is considered. It is improper to downgrade a reference on the basis that it teaches away, unless it teaches away in the context of the combination of references. In re Keller, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Merck & Co., Inc., 800 F. 2d 1091, 1096, 231 USPQ 375, 380 (Fed. Cir. 1986).

As to Appellants' assertion of a lack of showing by the Examiner of a reasonable expectation of success for the combination of Stefanopoulos and Schmandt, we find, aside from its appearance for the first time in the Request, such assertion to be unpersuasive. Obviousness does not require absolute predictability. Despite some users less than positive experiences with the speech interface of Schmandt, the entirety of the disclosure of Schmandt would, in our view, lead to reasonable expectation of success when combining Schmandt's speech interface techniques with other system applications such as described in Stefanopoulos. While evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness, no such evidence aside from attorney arguments has been forthcoming from Appellants.

We further find Appellants assertion' (Request, page 12) that we affirmed the wrong 35 U.S.C. § 103 rejection to be misplaced. The 35 U.S.C. § 103 rejection before us on appeal, and which we affirmed, was the rejection of appealed claims 1-19 based on the combination of Stefanopoulos and Schmandt. The Examiner's statement of the grounds of rejection set forth in the final Office action mailed March 27, 1997, and repeated in the Answer, asserted the obviousness of all of the claim limitations

Appeal No. 1998-1109
Application No. 08/419,229

to the skilled artisan when considering the collective teachings of the applied references. We agreed with the Examiner that a clear logical inference drawn from Schmandt is that the disclosed multiple workstations would be routinely interconnected in a network to provide access to system software. "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). We also point out that Appellants' Brief is completely silent as to any supposed "wrong" rejection being sent to the Board for decision.

As to Appellants' arguments (Request, pages 6-11) directed to the "grammar" related features appearing primarily in appealed claims 5-19, we find no error in our finding that, when considering the entirety of the record in this application, the Examiner's line of reasoning was sufficient to shift the burden to Appellants to come forward with evidence to rebut the Examiner's position as to the inherency or obviousness of the claimed features. We also find no error in our ultimate conclusion that Appellants' reliance solely on attorney arguments which merely repeated the language of the claims with a general

Appeal No. 1998-1109
Application No. 08/419,229

assertion that the applied references do not suggest the claimed features was insufficient to overcome the Examiner's position. Arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F. 2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F. 3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

We have granted Appellants' request to the extent that we have reconsidered our decision of February 28, 2001, but we deny the request with respect to making any changes therein.

REHEARING/DENIED

Jerry Smith

JERRY SMITH)
Administrative Patent Judge)
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Joseph F. Ruggiero)
JOSEPH F. RUGGIERO) BOARD OF PATENT
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Appeal No. 1998-1109
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